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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Kenneth L. Miller

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EXAMINER

HSU, RYAN

ART UNIT

PAPER NUMBER

3714

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/784,353	MILLER, KENNETH L.	
	<b>Examiner</b>	<b>Art Unit</b>	
	RYAN HSU	3714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 March 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 and 22-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 22-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/16/08, 2/20/09, 4/6/09</u> .                                | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

In response to the amendments filed on 3/5/09, claims 1, 6, 9, 15, 23, 25, 27, 30, and 37, have been amended. Claims 1-16 and 22-38 are pending in the current application.

#### ***Information Disclosure Statement***

1. Applicant should note that the large number of references in the attached IDS have been considered by the examiner in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. **See MPEP 609.05(b).** Applicant is requested to point out any particular references in the IDS which they believe may be of particular relevance to the instant claimed invention in response to this office action.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-17 and 22-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brenner et al. (US 5,830,068 A) and Scarne's New Complete Guide to Gambling and further in view of Wonderland Wagering Guide (herein referred to as "WWG") teaching the "Evening-Twin-Tri" as of April 3, 2002 and the "Tri-Super" as of December 11, 2002 as evidenced by the [www.archive.org](http://www.archive.org) ("Wayback Machine") and further noted to OLBG**

**Betting School [www.online-betting-guide.co.uk/school/horse\\_racing\\_bets.php](http://www.online-betting-guide.co.uk/school/horse_racing_bets.php) retrieved on 5/19/2009.**

2. Regarding claims 1–6, 9, 15, 22–23, 25, 27, and 30–38, Brenner teaches a method comprising the steps of receiving at a computer from a player choices a plurality of races chosen by the player from among races at an event. A teaching for an electronic horse wagering system by description is commonly understood in the art to provide a user with the ability to select the horse that they choose to wager on in an event and pay the wager if the predetermined conditions are met (*see col. 5: ln 50–col. 6: ln 20*). Brenner specifically teaches a computer permitting the player to choose races of the player's own choosing and permitted by the computer to be non-consecutive and allowing the player to choose winners of each of the chosen event's to be included in a wager (*ie: "pick-n" and "daily double"*) (*see col. 5: ln 50–col. 6: ln 26*). An electronic format is chosen to accurately track and adapt a system to provide program information as well as provide the expected result allowing player to wager any type of wager they desire. Additionally, Brenner teaches the computer to calculate the payment to the player if a number of the selected winners within the wager win corresponding to the chosen races (*see totalisators [102–108], col. 5: ln 59–col. 6: ln 54*). Brenner's description of a electronic wagering system incorporates the features of as described above. The nature of wager on a racing event is an agreement where a player places a monetary amount on a prediction of where the horse will place in the racing event. If the prediction is correct then the player is paid out on the predetermined odds agreed upon at the time of the wager. Although Brenner

does not explicitly recite the incorporation of forming at least a portion of each bet to form a pool and sending at least a portion of the pool to each of the identified winning players the totalisators in its embodiments are described to incorporate the ability to perform the calculations in this manner (*see col. 6: ln 10-20*). However, Brenner does not specifically teach a wager that includes a plurality of non-consecutive horse racing events to be included in a unified wager.

3. In an analogous gaming reference, Scarne's teaches the premise behind horse betting wagers and how they have revolved around the use of what is known as pari-mutuel pools. These pools are created in order to derive the odds for a horse race and thus are able to generate larger prizes for wagers as well as adapt the payout 'odds' from a direct result of the wagering habits of the players involved in the pool (*see pg. 32-55*). One would be motivated to incorporate the teachings of Scarne in order to understand the different types of horse wagering bets and how they are set up in the gambling industry. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Scarne on the background of horse betting with that of Brenner to realize that the wagers that are discussed in Brenner are art equivalents to those discussed in Scarne and therefore wagers are pooled once the results from races are received one would identify a set of winning players from a plurality of players and send at least a portion of the pool to one or more identified winning players. In an attempt to further explain the underlying principles of the racing art, the receiving and processing of wagers made by a plurality of players would also be equivalent of the limitation a first player making a first wager, a second player making a second wager,

and a third wager making a third wager. By distinguishing such steps the claims are not further limited or change in scope. The use of the different wagers from different players to be performed are alternative ways to describe a betting pool as taught in Scarne and therefore the claims encompass identical subject matter. Furthermore, the ability to receive an additional wager after a racing event has begun common feature of racing events depending upon the rules and regulations of the jurisdiction where the race is taking place. Due to the nature of the pari-mutuel pool, the odds constantly change and tracks allow the placement of bets even after the race has begun and will usually have a cut off at some point before the race is finished. However, Brenner and Scarne's are still silent with respect to the ability to create a unified wager that includes choosing winners of a non-consecutive plurality of contests from among the contests of an event. .

4. In an analogous gaming reference, Wonderland Wagering Guide (herein referred simply as WWG) teaches of the different options that are provided by the wagering system. WWG teaches of a wager that can be made by a plurality of players in the "exotic bets" section. WWG teaches of a wager called the "Evening Twin-Tri" and the "Tri-Super". The "Evening Twi-Tri" and the "Tri-Super" are wagers that allow the player to place a wager on a plurality of nonconsecutive races. Additionally, these wagers cause allow the player to bet on multiple contestants for each event contest and the player is paid accordingly if a predetermined number of selected contestants wins a corresponding event contest (see *'Wonderland Wagering Guide'*). One would be motivated to incorporate such a feature as to provide the player with addition wagering options to the user. By combining the teachings of WWG with the system of Brenner and Scarne it

would yield the predictable result of providing a system that greatly increased player excitement and appeal. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the features of WWG into the wagering system of Brenner and the teachings of Scarne's.

5. Furthermore, OLBG Sports teaches the state of the art in explaining the type of wagers that are commonly used in horse racing. As established above, Brenner is capable of providing the user with a means to place a wager on an electronic system. OLBG is incorporated only to provide a more thorough understanding of the art with respect to 'unified wagers'. OLBG teaches that multiple bets can be chosen based upon the needs of the user ('make your own multiples bet'). Additionally, OLBG teaches Lucky 63, Heinz, Super Heinz and Goliath which are all wagers that provide examples of a unified wager incorporate a plurality of non-consecutive racing events in a single wager. One would be motivated to incorporate these additional wagering options to provide a system that greatly increases player customization therefore providing a more enjoyable experience for a player. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of OLBG to provide the state of the art of the horse racing industry at the time the invention was made.
6. Regarding claims 7-8, 24, 26, 28-29, Brenner teaches a method of receiving from the player a bet on multiple contestants for a single contests (*ie: show, pick-n type bets*) and pays the player if at least one of the selected contestants places in a corresponding selected event contest (*see totalisator [102], col. 5: ln 50-col. 6: ln 19*).

7. Regarding claim 10, Brenner teaches a method wherein the selection of races and predicted winners is associated with a game card (*see Fig. 17 and the related description thereof*).
8. Regarding claim 14, Brenner teaches a method wherein the player must respectively select a single horse for each selected race in a "pick-n" type game (*see col. 6: ln 10-20*).
9. Regarding claims 11-13, 16-17, Brenner is silent with respect to teaching a wager being placed that allows a player to make a wager on a plurality of wagers on nonconsecutive races.
10. In an analogous gaming reference, Wonderland Wagering Guide (herein referred simply as WWG) teaches of the different options that are provided by the wagering system. WWG teaches of a wager that can be made by a plurality of players in the "exotic bets" section. WWG teaches of a wager called the "Evening Twin-Tri" and the "Tri-Super". The "Evening Twi-Tri" and the "Tri-Super" are wagers that allow the player to place a wager on a plurality of nonconsecutive races. Additionally, these wagers cause allow the player to bet on multiple contestants for each event contest and the player is paid accordingly if a predetermined number of selected contestants wins a corresponding event contest (*see 'Wonderland Wagering Guide'*). One would be motivated to incorporate such a feature as to provide the player with addition wagering options to the user. By combining the teachings of WWG with the system of Brenner it would yield the predictable result of providing a system that greatly increased player excitement and appeal. Therefore it would have been obvious to one of ordinary skill in the art at the



time the invention was made to incorporate the features of WWG into the wagering system of Brenner.

***Response to Arguments***

1. Applicant's arguments filed 4/6/09 have been fully considered but they are not persuasive.
2. With respect to parts I-IV of the applicant's response, the arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Personal opinions and feelings that are indicative of applicant's displeasure on the prosecution are not constructive or relevant with respect to the argument at hand. An example of this few is clear from applicant's own response and refusal to advance prosecution (part I. section D) which states that "Applicant has found that it is a fool's errand to try and speculate what an examiner might have in mind but did not put on paper[.] Until a complete, clear, organized, and rule-compliant Office Action is stated, Applicant can go no further than to articulate the defects." There is no legal argument to such arguments as a general allegation of defects does not amount to a proper defense the rejection presented. The applicant's representative is to provide potentially the ways in which the prior art of record fails to provide certain limitations of the claimed invention rather than present spurious arguments. Currently, the example provided above is one of many in the applicant's arguments that are not productive in the prosecution process as are not directed towards a valid legal argument but are simply the opinions expressed by the

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representative. The applicant is reminded that he is to provide a *bona fide* attempt to advance the application or the reexamination proceeding in his response to an office action.

3. With respect to part I sec. A: WWG has been incorporated to specifically address the claim language “non-consecutive plurality of races” (*see rejection above*). With respect to contest the Examiner has used racing event, horse racing event, or race to be equivalent to a contests as this terms are generally considered art unit equivalents in the racing arts.
4. With respect to part I sec. B: Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. A general allegation reflecting the applicant's discontent with respect to the Office Action does not further advance prosecution. It is advised that the applicant should provide a recitation towards the specific areas in which the office action lacks in clarity and is imprecise rather than a general statement that appears to be more of a bad faith effort in responding to the office action rather than a proper reply.
5. With respect to part I sec. C: The applicant contends that the reliance on inherency exceeds permissible bounds. The Examiner respectfully disagrees. The inherent aspects recited in the office action dated 9/5/08 were used in an attempt to describe the underlying principles prevalent and understood by one of ordinary skill in the gaming arts. An explanation of describing what a wager would be an inherent attribute of a system that provides a user the ability to place horse wagers. As the specification of a

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patent is only required to include those features that are novel in the art, such a description would not exist in the written description but would be part of the underlying knowledge that one would require to understand how the system works. The applicant's representative quotes to MPEPE 2112 of providing evidence and or rationale for evidence of inherency which has been provided through incorporating the art of Scarne's and WWG. Regardless the word inherency has been removed from the record above and replaced with a teaching for the common state of the art which would be obvious for one to incorporate into the gaming system of Brenner and therefore the applicant's arguments are moot.

6. With respect to part IV: 707.07(k) Numbering Paragraphs, the Examiner acknowledges the applicant's opinion on such a matter however, his assertion with respect to confusion is not dispositive in the manner and amounts to more spurious arguments. The Examiner has clearly labeled each section of the office action, included page numbers, and provided a clear heading with respect to where the limitations of each claim is addressed (ie: pg. 3: "Regarding claims 1-6,9, 15, 22-38"). The argument appears to be made to indicate a dissatisfaction with the Examiner's writing style more than an argument against the subject matter or at best an the applicant's preferred writing format. In this instance, in an effort to provide a more clear and thorough response the Examiner has implemented a narrative style in order to avail the applicant of the reasoning and position the Examiner has taken while reviewing the claimed subject matter. It is unfortunate that the message was not clearly received by the applicant's representative. However it is noted that, in the example cited by the applicant's representative, he directs the Examiner's attention to

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the unclear nature of the rejection of claims 1 and 15. It is not clear how the numbering of paragraphs will remedy this matter. While the paragraph might be two pages in length, if a numbering of paragraphs were included then it is not seen how a number in front of the stated paragraph would have helped identifying the one or two sentences within that paragraph. Since such an argument is rather superfluous and irrelevant to the state of the art or the prior art of record, the Examiner has included paragraph numbers for the instant office action as per the applicant's request.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN HSU whose telephone number is (571)272-7148. The examiner can normally be reached on 9 :00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on (571)272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/  
Supervisory Patent Examiner, Art Unit 3714

RH  
May 26, 2009